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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,044	04/19/2000	Hans-Ulrich Buschhaus	Mo-5586-LeA 33,605	3337

34947 7590 01/07/2004

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PATENT DEPARTMENT
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EXAMINER	
REDDICK, MARIE L	
ART UNIT	**PAPER NUMBER**
1713	18

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/552,044	BUSCHHAUS ET AL.	
	Examin r	Art Unit	
	Judy M. Reddick	1713	

--The MAILING DATE of this communication app ars on the cover sheet with th correspondence address --

THE REPLY FILED 28 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *28 November 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: *NONE*.

Claim(s) objected to: *NONE*.

Claim(s) rejected: *40-47*.

Claim(s) withdrawn from consideration: *NONE*.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☒ Other: *See Continuation Sheet*

Judy M. Reddick
Primary Examiner
Art Unit: 1713

Continuation of 5. does NOT place the application in condition for allowance because: of reasons clearly set forth in the previous Office Action per paper no. 17(07/28/03).

Continuation of 10. Other: As to the 112, 2nd paragraph issue----Counsel argues that when read in light of the specification, the term "acrylate dispersions" would be readily understood by one of ordinary skill in the art. However, this is not deemed to be persuasive because the limitations on which applicant relies are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064. Claims may be interpreted in the light of the specification for the purpose of defining a given term under 35 USC 112 but it must be remembered that during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 13 USPQ 1320 Generally, one does not read into claims in pending applications limitations from the specification. In re Winkhaus, 188 USPQ 129; In re Prater, 162 USPQ 541. Moreover, "acrylate dispersion(s)" is as it appears in the specification(page 2, lines 12 & 15). As to Eversole et a -it is urged and maintained that as to "storage stability" is would be expected to be possessed by the coating composition of Eversole et al, as modified since it is the same as the claimed composition and there is absolutely nothing viable on this record diffusing this issue. Moreover, Counsel is directed to review the paragraph bridging cols. 1 and 2 of Eversole et al wherein storage of the coating is discussed. Counsel has not proffered any objective evidence establishing that the coating composition of Eversole et al is not storage stable. To this end, mere Counsel's arguments, unsupported by factual evidence, are given little weight, In re Lindner(173 USPQ 356). As to Ludwig et al--Counsel is reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in noway limited to the working Runs, i.e., the specification need not contain working examples if the invention is disclosed in such a manner that one skilled in the art would be able to practice it without an undue amount of experimentation(In re Borkowski, 162 USPQ 642).